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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/803,631	03/18/2004	Blaine H. Dolph	AUS920040046US1	5810
37945	7590	04/02/2010	EXAMINER	
DUKE W. YEE YEE AND ASSOCIATES, P.C. P.O. BOX 802333 DALLAS, TX 75380			TEKLE, DANIEL T	
			ART UNIT	PAPER NUMBER
			2621	
			NOTIFICATION DATE	DELIVERY MODE
			04/02/2010	ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

ptonotifs@yeeiplaw.com

<b>Office Action Summary</b>	<b>Application No.</b> 10/803,631	<b>Applicant(s)</b> DOLPH, BLAINE H.	
	<b>Examiner</b> DANIEL TEKLE	<b>Art Unit</b> 2621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on December 16, 2009.
- 2a) ☒ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-22 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## DETAILED ACTION

### *Response to Argument*

Applicant's arguments with respect to claim 1-22 have been considered but are moot in view of the new ground(s) of rejection.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 1-22 rejected under 35 U.S.C. 103(a) as being unpatentable over Freeman et al. (US 2001/0013123) further in view of Franeo (US 2002/0046407).

**Regarding Claim 1:** Freeman et al and Franeo discloses a method for modifying an original marketing content stored within a memory of a Digital Video Recorder (DVR) comprising: sending, by a processor of a service provider (paragraph 0079 of Freeman et al.), a television program containing the original marketing content from the service provider (paragraph 0027 and 0031 of Freeman et al.), to a DVR (paragraph 0090 of Franeo); receiving, by the processor (paragraph 0021 of Franeo), a user ID (paragraph 0068 of Franeo) and a program ID (paragraph 0041 and 0064 of Freeman et al.) from the DVR (paragraph 0090 of Franeo); and responsive to receiving the user ID (paragraph 0021 and 0068 of Franeo) and the program ID (paragraph 0041 and 0064 of Freeman et al.) at the processor (paragraph 0021 of Freeman et al.), determining, by the processor, a location of the user by referencing a

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user profile (paragraph 0081 of Freeman et al.) associated with the user ID (paragraph 0021 and 68 of Franeo), and sending by the processor, a local marketing content to the DVR (paragraph 0090 of Franeo), wherein the local marketing content is based on the location of the user and the program ID (paragraph 0041 and 0081 of Freeman et al.).

It would have been obvious to one ordinary skill in the art at the time of the invention was made to combine Franeo invention into **of Freeman et al.** invention in order to store a user requested program at the user station.

**Regarding Claim 2:** Freeman et al and Franeo discloses a method of claim 1 further comprising: determining whether no local marketing content exists for the television program **(paragraph 0033 of Freeman et al.);** and responsive to a determination that the no local marketing content exists for the television program **(paragraph 0028 of Freeman et al.), sending a message indicating that no local marketing content exists for the television program (paragraph 0028 of Freeman et al.) to the DVR (paragraph 0090 of Franeo).**

**Regarding Claim 3:** Freeman et al and Franeo discloses a method of claim 1, further Freeman et al. discloses wherein the local marketing content is add-on marketing content **(paragraph 0073 and 0090 of Freeman et al.).**

**Regarding Claim 4:** Freeman et al and Franeo discloses a method of claim 1, further Freeman et al. discloses wherein the local marketing content is a replacement marketing content **(paragraph 0090 of Freeman et al.);**

**Regarding Claim 5:** Freeman et al and Franeo discloses a method of claim 1 the local marketing content is an overlay marketing content (**paragraph 0073 and 90 of Freeman et al.**).

**Regarding Claim 6:** Freeman et al and Franeo discloses a method for modifying a marketing content stored within a memory of a Digital Video Recorder (DVR) comprising: responsive to receiving, by the processor (**paragraph 0021 of Freeman et al.**), a local marketing content from a service provider (**paragraph 0018 of Freeman et al.**) in response to sending the user ID (**paragraph 0021 and 68 of Franeo**) and the program ID (**paragraph 0041 and 0064 of Freeman et al.**), replacing the marketing content with the local marketing content in the memory (**paragraph 0073 and 0090 or Freeman et al.**).

**Regarding Claims 7, 9-11:** Claims 7 and 9-11 are rejected for the same subject matter as claims 2-5 respectively.

**Regarding Claim 8:** Freeman et al and Franeo discloses a method of claim 7, wherein the location of the user is determined by cross-referencing the user ID with information stored in a user profile associated with the user ID (**paragraph 0049 of Freeman et al. and paragraph 0021 of Franeo**).

**Regarding Claims 12-22:** Claims 12-22 are rejected for the same subject matter as claims 1-11 respectively.

### ***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to DANIEL TEKLE whose telephone number is (571)270-1117. The examiner can normally be reached on 7:30am to 5:00pm M-R and 7:30-4:00 Every other Friday..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Marsha D. Banks-Harold can be reached on 571-272-7905. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Marsha D. Banks-Harold/  
Supervisory Patent Examiner, Art Unit 2621

/Daniel Tekle/  
Examiner, Art Unit 2621